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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/720,356

11/13/2000

Katsuma Fujii

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7590

12/10/2004

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/720,356

Applicant(s)

FUJII, KATSUMA

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Receipt is acknowledged of the Pre-Amendment received on 22 December 2000.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (US 5,501,491).

Thompson teaches a card medium with 4 identification sections formed on the card main body that are stripably removable, indicate information, and are applied to an object (FIG. 12). The Examiner notes that the type of information printed thereon (musical characters, shops seal, song information, etc., and where to apply it; i.e. the limitations set forth in claims 1-14) are a matter of intended use, as the indicia is merely placed on the substrate/card without a specific/defining functional relationship between the type of information printed thereon, and the substrate it belongs to, where the "stickers" are to be removed to be applied to an object for information purposes. The claims merely recite types of information that are on removable parts of a card/carrier that are to be applied to an object, as is old and well known in the art. Therefore, it would be obvious to one of ordinary skill in the art to place any type of data (indicia) on the substrate (in the form of a removable label/sticker) to be applied to an object, as

the applicant has not stated the criticality of having just a particular type. The Examiner notes, specifically, when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability (Gulack, *In re*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) 2106, 2112.01). In the instant case, the substrate is only used as a carrier substrate/support to hold the descriptive material (labels/stickers). Therefore the Examiner notes that it would have been obvious to an artisan of ordinary skill in the art to include such stripably removable information on a card, especially since cards/forms with strippable/peelable information are well known, as are information/indicia/descriptive material including musical characters, shops seals, songs, disc jackets, indexes, etc. The Examiner notes that business forms/sheets with removable stickers/labels thereon on, are well known and conventional (see below), and such sheets are broadly are interpreted as card mediums, and can also read upon the claims (see US 5,702,789 for example). Labels/stickers are well known to be removed from a card/sheet and placed on objects for information purposes, and accordingly, such limitations set forth in the claim are a matter of intended use, in addition to being well known and conventional in the art (see prior art cited below for examples of labels, as well).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Woods (US 4,757,901), Cates (US 2002/0047261), Oliver et al. (US 5,632,842), Fernandez-Kirchberger et al. (US 5,702,789), Zumberge (US 2002/0079691), Silvestre (US

2002/0089171), Viby (US 2002/0096874), Lee (US 6,589,624), Winsky et al. (US 5,739,451), Seiki (US 5,715,935), Tarrant (US 4,507,883), and Rawlings (US 6,511,725).


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW
9/15/04



KARL D. FRECH
PRIMARY EXAMINER